

### **Amendments to the Claims**

Claim 1 (Currently amended): Hybrid maize seed designated 38T27, representative seed of said hybrid 38T27 having been deposited under ATCC accession number ~~PTA-4267~~ PTA-4270.

Claim 2 (Original): A maize plant, or its parts, produced by the seed of claim 1.

Claim 3 (Original): Pollen of the plant of claim 2.

Claim 4 (Original): An ovule of the plant of claim 2.

Claim 5 (Currently amended): A tissue culture of regenerable cells or protoplasts of said cells of a hybrid maize plant 38T27, representative seed of said hybrid maize plant 38T27 having been deposited under ATCC accession number ~~PTA-4267~~ PTA-4270.

Claim 6 (Previously amended): The tissue culture according to claim 5, the cells or protoplasts of said cells having been isolated from a tissue selected from the group consisting of leaves, pollen, embryos, roots, root tips, anthers, silks, flowers, kernels, ears, cobs, husks, and stalks.

Claim 7 (Currently amended): A maize plant, or its parts, regenerated from the tissue culture of claim 5 and capable of expressing all the morphological and physiological characteristics of hybrid maize plant 38T27, representative seed having been deposited under ATCC accession number ~~PTA-4267~~ PTA-4270.

Claims 8-19 (Previously canceled)

Claim 20 (Original): A maize plant, or its parts, having all the morphological and physiological characteristics of the plant of claim 2.

Claims 21-32 (Previously canceled)

Claim 33 (Currently amended): A method of making a hybrid maize plant designated 38T27 comprising:

crossing an inbred maize plant GE533329, deposited as ~~PTA-4340~~ PTA-4286 with a second inbred maize plant GE501400, deposited as ~~PTA-1715~~ PTA-1282; and developing from the cross said hybrid maize plant representative seed of which having been deposited under ATCC Accession Number ~~PTA-4267~~ PTA-4270.

Claims 34-42 (Previously canceled)

Claim 43 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a mutant gene or a transgene that encodes a product that confers insect resistance into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 44 (New): The maize plant produced by the method of claim 43 wherein said mutant gene or transgene is an insect resistance gene encoding a *Bacillus thuringiensis* polypeptide.

Claim 45 (New): The maize plant produced by the method of claim 43.

Claim 46 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a mutant gene or a transgene that encodes a product that confers herbicide resistance into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 47 (New): The maize plant produced by the method of claim 46 wherein said mutant gene or transgene is an herbicide resistance transgene selected from the group consisting of: a transgene conferring glyphosate resistance, a transgene conferring glufosinate resistance, a mutant gene or transgene conferring imidazolinone resistance and a mutant gene or transgene conferring sulfonylurea resistance.

Claim 48 (New): The maize plant produced by the method of claim 46.

Claim 49 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a mutant gene or a transgene that encodes a product that confers disease resistance into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 50 (New): The maize plant produced by the method of claim 49.

Claim 51 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a gene that confers male sterility into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 52 (New): The method of claim 51 wherein said F1 hybrid maize plant further comprises said gene that confers cytoplasmic male sterility.

Claim 53 (New): The maize plant produced by the method of claim 51.

Claim 54 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a gene that encodes a product that confers imidazolinone resistance into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 55 (New): The maize plant produced by the method of claim 54.

Claim 56 (New): A method of making an F1 hybrid maize plant comprising:

1) introgressing a mutant gene or a transgene that encodes a product that modifies fatty acid metabolism, that decreases phytate content, or that modifies starch metabolism into at least one of inbred maize parent plants GE533329 and GE501400, representative samples of which have been deposited as PTA-4286 and PTA-1282 respectively, and

2) crossing said inbred maize parent plants to produce said F1 hybrid maize plant.

Claim 57 (New): The maize plant produced by the method of claim 56.

Claim 58 (New): The maize plant produced by the method of claim 43 wherein said maize plant exhibits no statistically significant variation from 38T27, other than variation caused by the addition of said mutant gene or transgene, and wherein significance is determined at a 5% significance level when grown in the same environmental conditions as 38T27.

## **REMARKS**

The present application relates to hybrid maize plant and seed 38T27. Claims 1, 5, 7, and 33 have been amended. Claims 43-58 have been added. No new matter has been added by the present amendment. Applicant respectfully requests consideration of the following remarks.

### **Detailed Action**

#### *A. Allowable Subject Matter*

Claims 1-7, 20, and 33 were given a Notice of Allowability by the Examiner on May 2, 2003. Applicant is withdrawing from issue the above-identified case in accordance with MPEP §1308 and 37 C.F.R. §1.114 and submitting this preliminary amendment in conjunction with a Request for Continued Examination.

Applicant disagrees with the Examiner's reasons for allowance. Specifically, the Examiner states the prior art also does not teach the inbred parents of 38T27. Rather, such statement should read, the prior art does not teach the combination of the inbred parents to create hybrid 38T27.

#### *B. Claims and Specification*

Applicant acknowledges the objection to the specification for the presence of a blank line on page 7 as withdrawn.

Applicant acknowledges the objection to claims 6, 12, 16, 25 and 29 as withdrawn. The rejections of claims 1-32 under 35 U.S.C. § 112, second paragraph, is acknowledged as withdrawn in light of the claim amendments. Applicant acknowledges the rejection of claims 1-32 under 35 U.S.C. § 112, first paragraph, requiring a deposit of the maize seed of the invention, as withdrawn in light of the deposit and the deposit statement in the specification and the paper received on November 13, 2002. Finally, Applicant acknowledge the rejections of claims 1-32 under 35 U.S.C. § 102(e)/103(a) as withdrawn.

The foregoing amendments to the claims of this application provide compliance with the requirement of assuring unrestricted public availability of a source of reproductive material of the hybrid maize seed 38T27, deposited under ATCC accession number PTA-4270 and the inbred

parents GE533329 and GE501400, deposited under ATCC accession number(s) PTA-4286 and PTA-1282 of this invention.

Applicant respectfully submits as shown in the amendments to the claims, these corrections are needed for proper disclosure and protection of the invention and require no substantial amount of additional work on the part of the PTO. Applicant respectfully submits there was an inadvertent typographical error whereby the incorrect ATCC Accession No(s). were submitted as PTA-4267 for hybrid maize seen 38T27, PTA-4340 for inbred parent GE533329, and PTA-1715 for GE501400. Applicant herein submits the correct ATCC Accession No(s). are PTA-4270, PTA-4286 and PTA-1282 respectively. Applicant apologizes for this inadvertent typographical error. A copy of the receipt and viability statement for these deposits from the ATCC is attached.

Applicant submits, in order to expedite prosecution, new claims 43-58 list the type of traits that may be conferred. However it should be noted that 38T27 comprising a mutant gene or a transgene, even if it is for a transcription factor, is distinct from another hybrid maize plant comprising that same mutant gene or transgene and still retains the benefit of Applicant's invention.

Applicant has also added claim 58 to further describe the line produced in such a manner by traits that do not vary from the deposited line at a 5% significance level when measured in the same environmental conditions. Phenotypic traits, an identifying characteristic, are utilized by those of ordinary skill in the art to compare two lines, and a phenotypic comparison is the method used by the patent office to evaluate the novelty of the deposited line itself. One of ordinary skill in the art of plant breeding would know how to evaluate the traits of two plant varieties to determine if there is no statistically significant variation when determined, for example, at a 5% significance level and when grown in the same environmental conditions between the traits expressed by those varieties. For the reasons aforementioned, it is respectfully submitted that Applicants' claims are sufficiently described and enabled by the specification.

### **Conclusion**

In conclusion, Applicant submits in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



Edmund J. Sease, Reg. No. 24,741  
McKEE, VOORHEES & SEASE, P.L.C.  
801 Grand Avenue, Suite 3200  
Des Moines, Iowa 50309-2721  
Phone No: (515) 288-3667  
Fax No: (515) 288-1338  
**CUSTOMER NO: 27142**

Attorneys of Record

- mlw -